

**REMARKS**

**INTRODUCTION:**

Claims 1 – 7 are pending and under consideration. Reconsideration is requested.

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION:**

In the Office Action, at page 1, item 2a, the action was indicated as final. In the detailed Office Action remarks, however, there were no reasons for issuing this Office Action as a final office action. Applicant requests that the finality of the April 2, 2003 Office Action be withdrawn, that this Amendment be entered, and a subsequent Office Action be issued either in the form of a Notice of Allowance or a further Office Action at that time.

The reasons for withdrawal of the finality of the Office Action are clear. In response to the first Office Action dated October 18, 2002, applicant filed a response to that Office Action without any amendments made to the original claims 1-7. In other words, there were no amendments to the original claims 1-7 in responding to the first Office Action which would have justified making the second Office Action final. This is particularly true when the Examiner has now cited a new reference, U.S. Patent No. 6,370,149 B1 to Gorman et al. which he had not previously cited against the claims or even made of record in the first Office Action. In this second Office Action, the Examiner has cited a new reference to Gorman and has applied it as a primary reference in rejecting all of the claims 1-7 which still remain unamended and in original form, as filed. This new reference could have been cited in the first Office Action based upon the original claims that remain unamended. Therefore, withdrawal of the finality of the Office Action mailed April 2, 2003 is requested and warranted .

**REJECTIONS UNDER 35 U.S.C. §102**

In the Office Action, at page 2, numbered paragraph 2, claims 1, 2 and 4 were rejected under 35 U.S.C. §102 in view of Gorman et al. (U.S. Patent 6,370,149 B1). This rejection is traversed and reconsideration is requested. Gorman et al. is a newly cited reference in this last Office Action and applicant has not had an opportunity to provide comments thereon.

Gorman et al. discloses a telecommunication apparatus 180 for initiating and receiving voice and data comprising a first port 190 to connect the apparatus to a circuit switched telecommunication network PSTN, and a second port 188 to connect the apparatus to a packet based telecommunication network 40.

Gorman et al. also discloses gateway means 74 for establishing a path between a circuit switched telecommunication network PSTN and a packet based telecommunication network 40, **but this gateway means is NOT part of the telecommunication apparatus 180.** Fig. 4 col. 6, lines 8-10, describes a switch 74, which according to col. 5, line 50 – col. 6, line 8, is located in a “tandem location” 30. Fig. 1 col. 3, lines 26-32, describes a tandem location 30 as a separate switching center included in a telecommunication network run by a telephone company.

Claim 1 of the present invention (in original, unamended form) is directed to a telecommunication apparatus which specifies “...*gateway means for establishing a path between said first port and said second port **inside said apparatus** in response to a request embedded in an incoming call via said second port.*” (bolding added for emphasis). Independent claim 4 has equivalent language for the location of the gateway means. Gorman et al. accordingly does not anticipate the present invention as specified in the independent claims 1 and 4.

IP telephony systems used for toll bypass, which rely on Network Gateways, have been known for some time, and were described in the present patent application on page 2, second paragraph. The main object of the invention (page 4, lines 8-13) is to provide a system for all purpose IP telephony *which does not require Network Gateways in the system.* By including a gateway means inside end user telecommunications apparatuses, the capacity of the system will grow automatically with the number of users.

Claim 2 is dependent on claim 1 and should be allowable for at least similar reasons as claim 1.

#### REJECTIONS UNDER 35 U.S.C. §103:

In the Office Action, at page 4, claim 3 was rejected under 35 U.S.C. §103 in view of Gorman et al. and Phillips et al. (U.S. Patent 6,243,377 B1), and claims 5-7 were rejected in view of Gorman et al. and Naulus (U.S. Patent 6,259,691 B1). The reasons for the rejections are set forth in the Office Action and therefore not repeated. The rejections are traversed and reconsideration is requested.

Neither Phillips et al. nor Naulus discloses anything about gateway means inside an end user telecommunication apparatus. Therefore, Phillips and Naulus also lack such features as those lacking in Gorman et al., the primary reference.

Claims 3, and 5-7 are dependent on claims 1 and 4, respectively, and should be allowable for at least similar reasons as provided above for allowance of independent claims 1 and 4.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, the finality of the Office Action mailed April 2, 2003 should be withdrawn and this Amendment should be entered and another Office Action issued with the Examiner's reply to applicant's comments provided herein to narrow the issues for consideration.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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